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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,011	11/10/2003	Vladimir Mordekhay		6211

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Vladimir Mordekhay
c/o V. Balter
1045 Lassen Drive
Menlo Park, CA 94025

EXAMINER	
LEVKOVICH, NATALIA A	
ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/706,011	MORDEKHAY, VLADIMIR	
	Examiner	Art Unit	
	Natalia Levkovich	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11/10/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on 01/24/2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

"The memory device 26 has a plurality of individual electrical contacts 28a, 28b, ... 28n for powering the device and for interfacing of the memory device with external data inputting/outputting devices via a direct electrical connection with the aforementioned external data inputting/outputting devices, such as stations 100. 101, 102 shown in Fig. 2 and described later" (Specification, page 9, line 17);

" The information is loaded via direct electrical connection of contacts of the memory device, such as contacts 283, 28b. ... 28n (Fig. 1B). with the respective contacts of the station (not shown" (Specification, page 11, line 21).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. Claims 1-2, 4-5, 7-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "at least one sample analyzing station having direct electrical connection with said electrical contacts when said each one of said sample plates is inserted into said analyzing station'; a data input station for loading information into said built-in electronic memory via said direct electrical connection with said electrical contacts, when each one-of said sample plates is inserted into said data input station". Claim 21 recites "inputting into said built-in electronic memory information via a direct electrical contact ". The underlined statements are based on the new subject matter added to the disclosure and objected above.

The specification did not specifically recite direct electrical connection and electrical contacts in an analyzing station. Although the specification does teach means of data input / output, as well as electrical contacts on memory devices, there is no specific disclosure of respective contacts of a station and of direct electrical connection between memory devices and the station.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-2, 4-5, 7-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nova et al. (USP 6, 329, 139) in view of Ishinaga et al.(USP 6,474,789).

Nova teaches an automated system for "matrix materials with programmable data storage or recording devices or other memory means" (col.4, line 60). "The matrices may be in the form of... a test tube or microplates, 96 well or 384 well or higher density formats or other such microplates and microtiter plates. The matrices may contain one or a plurality of recording devices"..., a memory device may be embedded into matrices (col. 7, line 5) by various means including , for instance, being "mounted within well ... by adhesive or other bonding process, or may be press fit into the well" (col.58, line30)."In other embodiments, the memory is part of the container that contains the sample or is part of the instrument. " (Col.15, line 5). "The matrices with memories are used in assays, such as scintillation proximity assays [SPA], FP [fluorescence polarization] assays, FET [fluorescent energy transfer] assays, FRET [fluorescent resonance energy transfer] assays and HTRF [homogeneous time-resolved fluorescence] assays, the matrices may be coated with, embedded with or otherwise combined with or in contact with assay material, such as scintillant, fluophore or other fluorescent label" (col.7, lines 55-60). "These memory devices include dynamic random access memories

[DRAMS, which refer to semiconductor volatile memory devices that allow random input/output of stored information" (col.13, line 35).

Nova et al. do not teach memory devices having electrical contacts allowing direct electrical connections with the sample analyzing station. However, sample carriers/ substrates having recording/memory devices with electrical contacts for connecting to exterior electrical contacts, are well known in the art. For example, Ishinaga et al.(USP 6,474,789) discloses a substrate having plural recording elements and electrical leads for supplying electrical signals to the recording elements having electrical contacts for external electrical connections (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed memory devices with electrical contacts in the modified apparatus of Nova, in order to load information into built-in electronic memory.

Response to Arguments

Applicant's arguments filed on 01/24/2005 have been fully considered but they are not persuasive.

Applicant argues that the system taught by Nova et al. relates to sample processing, while the invention relates sample analysis.

The Examiner respectfully disagrees with this argument. The system of Nova is designed for both sample processing and analysis, as was discussed in the claim rejection above. Processing is necessary part of an analysis process.

With respect to the means of data input / output being connected to memory devices remotely versus directly, there are no limitations in the claims that would set forth a reason to prefer the latter over the former.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Jill Warden
Supervisory Patent Examiner
Technology Center 1700